

ESTTA Tracking number: **ESTTA509984**

Filing date: **12/10/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

### Petitioner Information

Name	ActiMuse, LLC		
Entity	Limited liability company	Citizenship	Texas
Address	1097 Yates Street Lewisville, TX 75057 UNITED STATES		

Attorney information	Scott A. Meyer Chalker Flores, LLP 14951 N. Dallas Parkway Suite 400 Dallas, TX 75254 UNITED STATES smeyer@chalkerflores.com,tjacks@chalkerflores.com,ecortez@chalkerflores.com m Phone:214-866-0001
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### Registration Subject to Cancellation

Registration No	4089155	Registration date	01/17/2012
Registrant	Addiction NV, LLC 17530 Von Karman Ave. Irvine, CA 92614 UNITED STATES		

### Goods/Services Subject to Cancellation


Class 003. First Use: 2009/11/30 First Use In Commerce: 2009/12/31  
All goods and services in the class are cancelled, namely: Cosmetics

### Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Mark Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	3301818	Application Date	09/21/2005
Registration Date	10/02/2007	Foreign Priority Date	NONE
Word Mark	ADDICTION		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 2005/03/18 First Use In Commerce: 2005/03/18 Cosmetics; Hair care preparations; Non-medicated skin care preparations
Attachments	78717240#TMSN.jpeg ( 1 page )( bytes ) Petition for Cancellation.pdf ( 17 pages )(518027 bytes )

### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/s/Scott A. Meyer
Name	Scott A. Meyer
Date	12/10/2012

## Page 1

2. The subject mark is identified in TESS and TARR as filed and owned by Addiction NV, LLC, a California limited liability company. See Exhibits A and B, respectively, attached hereto and made a part hereof for all purposes. However, upon information and belief, no such entity exists or has ever existed under the laws of the State of California. Therefore, ANV did not have standing to file its application for Respondent's Mark and it should therefore be cancelled.

3. Petitioner holds all right and title in and to U.S. Trademark Registration No. 3,301,818 ADDICTION ("Petitioner's Mark") in International Class 003 for use in connection with "cosmetics; hair care preparations; non-medicated skin care preparations" ("Petitioner's Goods"). The ADDICTION mark was filed on September 21, 2005, claiming a first use date of March 18, 2005 and a first use in commerce date of March 18, 2005. See Exhibit C, attached hereto and made a part hereof for all purposes.

4. Since March 18, 2005, Petitioner, its predecessors, or its related companies have continuously used the mark ADDICTION ("Petitioner's Mark") in interstate commerce as a trademark for, among other goods, cosmetics. Petitioner's Mark has also continuously appeared in promotion of Petitioner's cosmetic products such that Petitioner's Mark is closely identified with Petitioner's Goods and has gained very valuable public recognition. Petitioner's use of Petitioner's Mark began over four years prior to Registrant's alleged first use date. Petitioner has established an outstanding reputation as to the quality of its products sold under the ADDICTION mark. Thus, Petitioner is the prior user and owner of the trademark ADDICTION.

5. Petitioner has continuously used Petitioner's Mark in interstate commerce since long prior to any date upon which Respondent can rely. By virtue of its sales of high-quality products bearing Petitioner's Mark in interstate commerce, its expenditures of considerable sums

for promotional activities and the excellence of its products, Petitioner has developed significant goodwill in its ADDICTION mark and a valuable reputation.

6. Petitioner's trademark rights for its ADDICTION mark have priority over Respondent's Mark, inasmuch as Petitioner has continuously used Petitioner's Mark since it commenced use of its mark at least as early as 2005, and Respondent's mark lists a filing date of March 2, 2011, claiming first use date of November 30, 2009, and first use in commerce date of December 31, 2009.

7. Respondent's Mark so resembles Petitioner's Mark, ADDICTION, as they are currently used as to be likely to cause confusion, or cause mistake, or to deceive, in violation of Section 2(d) of The Trademark Act, 15 U.S.C. §1052(d), when used on or in connection with Respondent's Goods.

8. Under the circumstances, registration of Respondent's Mark is injuring and will continue to injure Petitioner by causing the trade and/or purchasing public to be confused, and/or deceived into believing that Respondent's Goods are those of Petitioner, or are sponsored by Petitioner, to Petitioner's detriment and damage, and will place a cloud over Petitioner's title to Petitioner's Mark in violation of Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d).

9. Petitioner's Mark ADDICTION is and was well established long before the filing date of Respondent's application for the subject registration and at the time that Respondent filed the application for the subject registration. Registration of Respondent's Mark is diminishing and diluting and will continue to diminish and dilute the distinctive quality of Petitioner's rights in Petitioner's Mark. Moreover, registration of Respondent's Mark is and will diminish the advertising value of Petitioner's Mark, and such registration will, in the event of any quality

problems involving the goods offered by Respondent, tarnish the distinctiveness of Petitioner's Mark.

10. Respondent's Mark is the same as, or substantially the same as, Petitioner's Mark, including in visual appearance, sound, commercial impression, similarity of goods, similarity of channels of trade, and pronunciation.

11. The similarity of Petitioner's registration and the subject mark as to appearance, sound, connotation and commercial impression is so great that the marks are confusingly similar. Therefore, consumers will likely be confused as to the source of goods under §1207.01.

12. Since Respondent's Mark disclaimed "COSMETICS," the subject mark is essentially ADDICTION NV. TMEP §1213 states that a disclaimer is a statement that the applicant or registrant does not claim the exclusive right to use a specified element or elements of the mark. Petitioner's Mark for ADDICTION and the subject mark for ADDICTION NV are nearly identical except for the dot after ADDICTION and the letters NV, and thus the marks are confusingly similar.

13. The subject mark is confusingly similar to Petitioner's Mark because the dominant word in both marks is ADDICTION. TMEP §1207.01(b)(iii) states, "if the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences." Section 1207.01(b)(vii) further states, "if two marks for related goods or services share the same dominant feature and the marks, when viewed in their entirety, create similar overall commercial impressions, then confusion is likely." In this case, the dominant portion of both Petitioner's registration for ADDICTION, and the Respondent's registration for ADDICTION NV is ADDICTION, making the marks confusingly similar.

14. Section 1207.01(b)(ii) of the TMEP states that “marks may be confusingly similar in appearance despite the addition, deletion or substitution of letters or words.” The addition of NV in Respondent’s Mark, ADDICTION NV, does not differentiate the marks. Therefore, the marks are sufficiently similar, despite the addition of letters in the subject mark, and there is a likelihood of confusion as to the source of the goods or services.

15. Section 1207.01(c)(ii) states that when considering whether confusion exists between composite marks that consist of a design element as well as words and/or letters, “if one feature of a mark is more significant than another feature, greater weight may be given to the dominant feature for purposes of determining likelihood of confusion,” and “if a mark comprises both a word and a design, greater weight is often given to the word, because it is the word that purchasers would use to refer to or request the goods or services.” Furthermore, Petitioner’s Mark was cited in a separate pending application by Respondent for the word mark ADDICTION NV COSMETICS, Serial Number 77/799,080. Petitioner respectfully submits that under TMEP §1207.01(c)(ii), Petitioner’s mark should have also been cited in the subject mark’s application for the design mark.

16. Therefore, the marks are confusingly similar as to the appearance of the marks because the subject mark disclaimed COSMETICS, leaving ADDICTION NV, the dominant word of each mark is identical, a word mark is stronger than a design mark, and the subject mark simply added NV COSMETICS. Since the claimable subject mark for ADDICTION NV is nearly identical to Petitioner’s registration for ADDICTION, the marks are confusingly similar and the subject mark should be cancelled.

17. Respondent’s Goods for cosmetics and Petitioner’s Goods for cosmetics are identical.

18. Respondent's Mark is likely to, and/or has, diluted and lessened the capacity of Petitioner's Mark to identify and distinguish Petitioner's Goods.

19. Respondent's Mark so resembles the continuously used Petitioner's Mark as to be likely, when used in connection with the goods as set forth in Respondent's registration, to lessen the capacity of Petitioner's Mark to identify and distinguish Petitioner's Goods.

20. The subject registration should be cancelled because Petitioner's rights of continuing its present use of Petitioner's Mark in commerce are, or will be, threatened by Respondent's registration of Respondent's Mark for Respondent's Goods, and because Petitioner's business will otherwise be damaged by Respondent's registration of Respondent's Mark for Respondent's Goods.

### **PRAYER**

WHEREFORE, the Petitioner prays that Trademark Registration No. 4,089,155 be cancelled.

Dated: December 10, 2012

Respectfully submitted,

CHALKER FLORES, LLP

By: /s/ Scott A. Meyer

Scott A. Meyer

State Bar No. 24013162

Thomas G. Jacks

State Bar No. 24067681

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**ATTORNEYS FOR PETITIONER**

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing PETITION FOR CANCELLATION was served on Respondent this the 10<sup>th</sup> of December, 2012, by sending the same via electronically through the Electronic System for Trademark Trials and Appeal (“ESTTA”) and first class mail, postage prepaid to:

Scott Simon, Registered Agent  
Addiction NV, LLC  
17530 Vonkarman Avenue  
Irvine, CA 92614

Nelson Quintero  
615 Hampton Drive, Unit A202  
Venice, CA 90291-2792

/s/ Scott A. Meyer  
Scott A. Meyer

**EXHIBIT A**

**ADDICTION NV COSMETICS MARK**



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<b>Word Mark</b>	ADDICTION NV COSMETICS
<b>Goods and Services</b>	IC 003. US 001 004 006 050 051 052. G & S: Cosmetics. FIRST USE: 20091130. FIRST USE IN COMMERCE: 20091231
<b>Mark Drawing Code</b>	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
<b>Design Search Code</b>	02.03.02 - Silhouettes of women; Women depicted as shadows or silhouettes of women 02.09.04 - Humans, including men, women and children, depicted sitting or kneeling; Kneeling, humans; Sitting, humans 26.01.21 - Circles that are totally or partially shaded.
<b>Serial Number</b>	85975943
<b>Filing Date</b>	March 2, 2011
<b>Current Basis</b>	1A
<b>Original Filing Basis</b>	1B
<b>Published for Opposition</b>	July 19, 2011
<b>Registration Number</b>	4089155
<b>Registration Date</b>	January 17, 2012
<b>Owner</b>	(REGISTRANT) Addiction NV, LLC LIMITED LIABILITY COMPANY CALIFORNIA 17530 Von Karman Ave. Irvine CALIFORNIA 92614
<b>Attorney of Record</b>	Nelson Quintero
<b>Disclaimer</b>	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "COSMETICS" FOR INTERNATIONAL CLASS 3 APART FROM THE MARK AS SHOWN
<b>Description of Mark</b>	Color is not claimed as a feature of the mark. The mark consists of the capitalized wording "ADDICTION NV" with a dot in between the two words and above the cursive lowercase lettering "cosmetics". To the left of all the wording is a silhouette of a woman.

Type of Mark      TRADEMARK  
 Register          PRINCIPAL  
 Live/Dead  
 Indicator          LIVE

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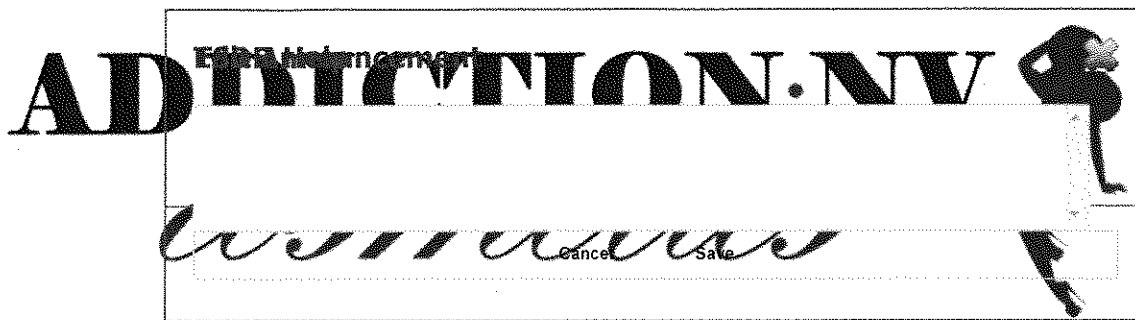
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**EXHIBIT B**

**ADDICTION NV COSMETICS TSDR STATUS**



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Mark: ADDICTION NV COSMETICS



US Serial Number: 85975943	Application Filing Date: Mar. 02, 2011
US Registration Number: 4089155	Registration Date: Jan. 17, 2012
Filed as TEAS Plus: Yes	Currently TEAS Plus: Yes
Register: Principal	
Mark Type: Trademark	
Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.	
Status Date: Jan. 17, 2012	
Publication Date: Jul. 19, 2011	Notice of Allowance Date: Sep. 13, 2011

### Mark Information

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Mark Literal Elements: ADDICTION NV COSMETICS

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Description of Mark: The mark consists of the capitalized wording "ADDICTION NV" with a dot in between the two words and above the cursive lowercase lettering "cosmetics". To the left of all the wording is a silhouette of a woman.

Color(s) Claimed: Color is not claimed as a feature of the mark.

Disclaimer: "COSMETICS" FOR INTERNATIONAL CLASS 3

**Design Search Code(s):** 02.03.02 - Silhouettes of women; Women depicted as shadows or silhouettes of women  
 02.09.04 - Sitting, humans; Humans, including men, women and children, depicted sitting or kneeling; Kneeling, humans  
 26.01.21 - Circles that are totally or partially shaded.

**Related Properties Information****Claimed Ownership of US** 85256374**Registrations:****Child Of:** 85256374**Goods and Services****Note:**

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks "\*" identify additional (new) wording in the goods/services.

**For:** Cosmetics**International Class:** 003 - Primary Class**U.S Class:** 001, 004, 006, 050, 051, 052**Class Status:** ACTIVE**Basis:** 1(a)**First Use:** Nov. 30, 2009**Use in Commerce:** Dec. 31, 2009**Basis Information (Case Level)****Current Owner(s) Information****Owner Name:** Addiction NV, LLC

**Owner Address:** 17530 Von Karman Ave.  
 Irvine, CALIFORNIA 92614  
 UNITED STATES

**Legal Entity Type:** LIMITED LIABILITY COMPANY

**State or Country Where** CALIFORNIA  
**Organized:**

**Attorney/Correspondence Information****Attorney of Record****Attorney Name:** Nelson Quintero**Docket Number:** 2383038T**Correspondent**

**Correspondent** NELSON QUINTERO  
**Name/Address:** NELSON QUINTERO  
 615 HAMPTON DR UNIT A202  
 VENICE, CALIFORNIA 90291-2792  
 UNITED STATES

**Phone:** 1-310-909-8535**Fax:** 1-310-388-5587**Correspondent e-mail:** [nquintero@quinterolaw.com](mailto:nquintero@quinterolaw.com)

**Correspondent e-mail No**  
**Authorized:**

**Domestic Representative - Not Found****Prosecution History**

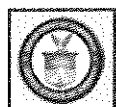
Date	Description	Proceeding Number
Jan. 17, 2012	REGISTERED-PRINCIPAL REGISTER	
Dec. 16, 2011	NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED	
Dec. 15, 2011	LAW OFFICE REGISTRATION REVIEW COMPLETED	70138
Dec. 09, 2011	ASSIGNED TO LIE	70138
Dec. 09, 2011	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Nov. 19, 2011	NOTICE OF DESIGN SEARCH CODE MAILED	
Nov. 18, 2011	STATEMENT OF USE PROCESSING COMPLETE	70565
Nov. 11, 2011	USE AMENDMENT FILED	70565
Nov. 18, 2011	DIVISIONAL PROCESSING COMPLETE	
Nov. 11, 2011	DIVISIONAL REQUEST RECEIVED	
Nov. 14, 2011	CASE ASSIGNED TO INTENT TO USE PARALEGAL	70565
Nov. 11, 2011	TEAS REQUEST TO DIVIDE RECEIVED	
Nov. 11, 2011	TEAS STATEMENT OF USE RECEIVED	
Sep. 13, 2011	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Jul. 19, 2011	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jul. 19, 2011	PUBLISHED FOR OPPOSITION	

Jun. 16, 2011	LAW OFFICE PUBLICATION REVIEW COMPLETED	68658
Jun. 16, 2011	ASSIGNED TO LIE	68658
Jun. 02, 2011	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jun. 02, 2011	EXAMINER'S AMENDMENT ENTERED	88888
Jun. 02, 2011	NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED	6328
Jun. 02, 2011	EXAMINERS AMENDMENT E-MAILED	6328
Jun. 02, 2011	EXAMINERS AMENDMENT -WRITTEN	81139
Jun. 01, 2011	ASSIGNED TO EXAMINER	81139
Mar. 08, 2011	NOTICE OF DESIGN SEARCH CODE MAILED	
Mar. 07, 2011	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Mar. 05, 2011	NEW APPLICATION ENTERED IN TRAM	

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**EXHIBIT C**  
**ADDICTION MARK**



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# ADDICTION

**Word Mark** ADDICTION

**Goods and Services** IC 003. US 001 004 006 050 051 052. G & S: Cosmetics; Hair care preparations; Non-medicated skin care preparations. FIRST USE: 20050318. FIRST USE IN COMMERCE: 20050318

**Standard Characters Claimed**

**Mark Drawing Code** (4) STANDARD CHARACTER MARK

**Serial Number** 78717240

**Filing Date** September 21, 2005

**Current Basis** 1A

**Original Filing Basis** 1A

**Published for Opposition** July 17, 2007

**Registration Number** 3301818

**Registration Date** October 2, 2007

**Owner** (REGISTRANT) Active Organics, Inc. CORPORATION TEXAS 1097 Yates Street Lewisville TEXAS 75057

(LAST LISTED OWNER) ACTIMUSE, LLC LIMITED LIABILITY COMPANY TEXAS 1097 YATES STREET LEWISVILLE TEXAS 75057

**Assignment Recorded** ASSIGNMENT RECORDED

**Attorney of Record** Edwin S. Flores

**Type of Mark** TRADEMARK

**Register** PRINCIPAL

**Live/Dead Indicator** LIVE

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